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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,933	07/30/2001	Gerd Frankowsky	12816-015001	4565
26161	7590	09/30/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			CHUNG, PHUNG M	
			ART UNIT	PAPER NUMBER
			2133	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,933

Applicant(s)

FRANKOWSKY, GERD

Examiner

Phung My Chung

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-13,17-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 3-5,14-16 and 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

1. Claims 6 and 17 recite the limitation "wherein sending the addresses includes sending a memory address and a location of the IC" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6, 9-13, 17, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Jamal (5,568,437).

As per claims 1-2, 6, and 9-11, Jamal discloses the invention substantially as claimed, comprising the steps of:

Scanning a plurality of ICs with an input signal, each IC having a plurality of data locations;

Comparing an output response at each data location with an expected value for the data location; and

Storing addresses in a buffer for each data location at which the response at the data location does not equal the expected value corresponding to the data location. (See col. 8, lines 5-19 and col. 7, lines 12-19).

As per claims 12-13, 17, 20 and 22, Jamal discloses the invention substantially as claimed, comprising:

At least one comparator (104) comparing at an output response at each of a plurality of data locations in a plurality of lcs with an expected value corresponding to the data locations; and

A processor is inherent in the system of Jamal for scanning the at least one comparator at each data location and sending addresses to a buffer when the response at each data location does not equal the expected value. (See col. 8, lines 5-19 and col. 7, lines 12-19).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamal (5,568,437) in view of Jones et al (5,856,923).

As per claims 7 and 8, the teaching of Jamal has been discussed above. Jamal does not disclose that the ICs can be tested either on a burn-in board or on a wafer. However, Jones et al disclose the ICs can be tested either on a burn-in board or on a wafer. (See col. 7, lines 29, col. 8, lines 8-10 and col. 1, lines 44-59)). Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the ICs that can be tested either on a burn-in board or on a wafer as taught by Jones et al into the invention of Jamal so that a variety of tests to ensure they will function properly once shipped.

As per claims 18 and 19, these claims are also rejected under the same rationale as set forth in claims 7 and 8.

6. Claims 3-5, 14-16 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 703-305-9686. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Phung My Chung
Primary Patent Examiner